

REMARKS

Claims 1-18, 20-22, 24-39, and 41-43 are pending after the amendment. Claims 23 and 44 are cancelled since the bulk of their language has been incorporated into the independent Claims 1 and 24, respectively.

Accordingly, the examiner's reasons for the rejections of Claims 23 and 44 are the pertinent issues to address.

Independent Claim 1 now recites the limitations of:

wherein said converting comprises changing any symbols on a pay line to the left of said special symbol, on the same pay line, to a leftmost symbol on said pay line or converting any symbols on said pay line to the right of said special symbol, on the same pay line, to a rightmost symbol on said pay line.

Independent Claim 24 has similar limitations. An example of such a method is shown in Figs. 3-5, where all symbols to the left or to the right of the special symbol (*) on the pay line have been converted to the symbol "a" because the "a" was the leftmost or rightmost symbol on the pay line.

The examiner rejected Claim 23 as being obvious over O'Halloran (Patent 6,439,993) in view of Bennett (Patent 6,089,977).

O'Halloran describes a game where the occurrence of a wild card on a pay line causes one or more other symbols on the same pay line to convert to the same wild card symbol. On page 2 of the Office Action, the examiner admits that O'Halloran does not change symbols to **other than** the special symbol (i.e., the wild card) on the same pay line. Regarding Claim 23, the examiner did not address the specific limitations but broadly rejected 22 claims (directed to various actions by the special symbol) by stating how each claim would be obvious by broad statements by O'Halloran such as how "other variations are obvious." The examiner should not have taken O'Halloran so literally, since the examiner still must provide a prima facie case for why the combination of the prior art suggest the claims. It is improper for the examiner to reject Applicant's claims due to

O'Halloran's statement that variations are obvious. Applicant's claims are examples of nonobvious variations.

Regarding Claim 23 (whose basic limitations are now in Claim 1), the special symbol converts all symbols to either the leftmost symbol or the rightmost symbol in the same pay line. This is very different from O'Halloran, which converts symbols to only wildcards. With wild cards, the symbols can be anything, so it is irrelevant what the end symbol is. In Bennett, the combination of a displayed iceberg symbol and coin symbol causes a penguin wild card to roam around the matix and turn various symbols into wildcards. There is no suggestion whatsoever of converting symbols to the leftmost or rightmost symbol (i.e., either a coin or an iceberg).

The results are very different. In Applicant's invention, the leftmost or rightmost symbol may be a low value symbol or a high value symbol, affecting the value of the award. This allows Applicant to enable the feature to occur more frequently than the O'Halloran feature since the value of the combination will typically be less than the O'Halloran award.


Accordingly, the examiner has not met his burden of proof to show Claim 1 (incorporating the pertinent limitations of Claim 23) is obvious. Independent Claim 24 is allowable for the same reasons.

Independent **Claims 11 and 33** include the limitation: "wherein said converting comprises converting all symbols adjoining said special symbol on multiple pay lines to special symbols identical to said special symbol." The examiner combined O'Halloran and Bennett to reject Claims 11 and 33 without giving any specific reason for why O'Halloran's broad statements would make these claims obvious. Neither O'Halloran nor Bennett suggests "converting all symbols adjoining said special symbol on multiple pay lines to special symbols identical to said special symbol." O'Halloran just teaches converting symbols on one pay line to wildcard symbols, and Bennet teaches a wildcard (a penguin) roaming around temporarily converting symbols to wildcards. The examiner indicated that Bennett's iceberg could be the special symbol, but no symbols are converted into the iceberg symbol.

Accordingly, allowance of all pending claims is respectfully requested.

Should the Examiner have any questions, the Examiner is invited to call the undersigned at (408) 382-0480.

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to: Mail Stop AF, Commissioner for Patents, P. O. Box 1450, Alexandria, VA 22313-1450, on the date shown below.


Signature

8/4/05
Date

Respectfully submitted,



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